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No. _____

IN THE

Supreme Court of the United States

OCTOBER TERM, 1991

ROPAK CORPORATION,

Petitioner,

v.

XYTEC PLASTICS, INC.,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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QUESTIONS PRESENTED

Rule 52(a), Fed.R.Civ.P., requires that, in granting or refusing interlocutory injunctions, "the court shall find the facts specially and state separately its conclusions of law thereon . . . which constitute the grounds of its action."

The questions presented are:

Whether the Court of Appeals erred as a matter of law in imposing the impossible burden on an appellant to demonstrate that the District Court did *not* consider evidence on a factual issue, in view of the District Court's *complete silence* on that issue.

Whether the Court of Appeals erred by requiring that a preliminarily-enjoined appellant "show that the [district] court actually failed to examine the prior art" in issuing the preliminary injunction, contrary to the Courts of Appeal's previous holding that a district court consider the prior art.

Whether the Court of Appeals erred as a matter of law by issuing a ruling directly inconsistent with its earlier decisions, thereby negating the court's central purpose: to "reduce the widespread lack of uniformity and uncertainty of legal doctrine that exist in the administration of patent law."

TABLE OF CONTENTS

Page

QUESTIONS PRESENTED i

TABLE OF CONTENTS ii

TABLE OF AUTHORITIES iv

OPINIONS BELOW 2

JURISDICTION 2

RULE INVOLVED 3

STATEMENT OF THE CASE 3

REASONS FOR GRANTING THE WRIT 8

I. Certiorari is Necessary to Correct the Court of Appeals' Clear Error on a Matter of National Importance 8

II. The Court of Appeals' Decision is Directly Contrary to the Language of the Rule, Legislative History and Case Law 11

A. The Court of Appeals Turned Rule 52 on Its Head 12

B. The Court of Appeals Imposed an Impossible Burden on Ropak 14

C. The Federal Circuit Has Negated its Central Purpose: Uniformity of the Patent Law 16

D. Counsel Cannot Waive The Provisions of Rule 52(a) 21

III. An Important Federal Procedural Issue Is Before This Court 22

CONCLUSION 23

APPENDIX 1a

Court of Appeals Opinion 1a

Court of Appeals Decision on Rehearing . . . 11a

Court of Appeals Judgment and Mandate 12a

Rule Involved 13a

TABLE OF AUTHORITIES

Cases: **Page**

Berguido v. Eastern Air Lines, Inc.
369 F.2d 874 (3rd Cir. 1966) 22

Connell v. Sears, Roebuck & Co.,
722 F.2d 1542, 220 USPQ 193
(Fed. Cir. 1983) 13

Cornelius v. Nutt, 472 U.S. 648 (1985) 10

Fluor Corp. v. United States ex rel Mosher Steel Co., 405 F.2d 823 (9th Cir. 1969), *cert. denied*, ___ U.S. ___, 23 L.ed2d 40 (1970) 22

Graver Tank & Mfg. Co. v. Linde Air Prods. Co., 339 U.S. 605 (1950) 14, 18

Panduit Corp. v. All States Plastic Mfg. Co., Inc., 744 F.2d 1564, 223 USPQ 465
(Fed. Cir. 1984) 17

Pullman-Standard v. Swint, 456 U.S. 66
(1982) 12

Smith v. James Irvine Foundation,
402 F.2d 772 (9th Cir. 1969),
cert. denied, 394 U.S. 1000 (1969) 13

United States v. General Motors Corp.,
384 U.S. 127 (1966) 20

United States v. United States Gypsum Co.
333 U.S. 364 (1948) 9, 11

We Care, Inc. v. Ultra-Mark, Int'l. Corp.,
930 F.2d 1567, 18 USPQ2d 1562
(Fed. Cir. 1991) 10, 17, 19, 20

Wilson Sporting Goods, Co. v. David
Geoffrey & Assoc., 904 F.2d 677,
14 USPQ2d 1942 (Fed. Cir. 1990) 18

Statutes, Regulations and Rules:

28 U.S.C. § 1254(1) 2

28 U.S.C. § 1295 9

28 U.S.C. § 1295(a)(4)(A) 2

Rule 52(a), Fed.R.Civ.P. i, 1, 3, 8, 9, 12, 13, 15, 20-23

Supreme Court Rule 29.1 1

Supreme Court Rule 23.1 2

Other:

Annot., 11 ALR Fed 207 (1972) 9

H.R. Rep. No. 312, 97th Cong., 1st Sess. 18-19 (1981) 10

Notes of Advisory Committee on Rule 52 for the 1937 Adoption 9

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

The petitioner Ropak Corporation respectfully prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Federal Circuit entered in the above-captioned proceeding on January 8, 1992.[1] The question presented is purely a legal one residing in the requirements of Rule 52(a) of the Federal Rules of

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[1] Pursuant to Rule 29.1 of the Rules of this Court, Ropak Corporation, a corporation of California, states that it has no publicly owned subsidiaries or affiliates.

Civil Procedure. Because the Court of Appeals' decision is so clearly erroneous, this case is appropriate for summary reversal pursuant to Rule 23.1 of the Rules of this Court.

OPINIONS BELOW

Upon application for a preliminary injunction to the United States District Court for the Eastern District of Michigan made by Xytec Plastics, Inc., the district court granted the injunction, but stayed the same upon an appeal taken to the United States Court of Appeals for the Federal Circuit requiring your petitioner to make a bond to effect the stay. The Court of Appeals affirmed the decision of the district court and the preliminary injunction was instituted.

The opinion of the Court of Appeals is not reported but is reprinted in the appendix ("Pet.App.") hereto, page 1a. The Court of Appeals denied Ropak's request for rehearing by order dated February 18, 1992 (Pet.App. 11a) and issued its judgment as a mandate on February 25, 1992 (Pet.App. 12a).

JURISDICTION

The jurisdiction of the Court of Appeals was invoked pursuant to 28 U.S.C. § 1295(a)(4)(A).

The decision of the Court of Appeals was entered on January 8, 1992. (Pet.App. 1a) and the Petition for Rehearing was denied February 18, 1992. (Pet.App. 11a) Jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

RULE INVOLVED

Rule 52(a) of the Federal Rules of Civil Procedure provides in part as follows:

> In all actions tried upon the facts without a jury or with an advisory jury, the court shall find the facts specially and state separately its conclusions of law thereon, and judgment shall be entered pursuant to Rule 58; and in granting or refusing interlocutory injunctions the court shall similarly set forth finding of fact and conclusions of law which constitute the grounds of its action.

The full text of Rule 52 is set forth in petitioner's appendix (Pet.App 13a).[2]

STATEMENT OF THE CASE

Ropak and Xytec market competing collapsible plastic bins for use in material handling. Ropak entered this market through its purchase of certain assets of J.I.T. Corporation ("J.I.T.")[3] in May, 1989.

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[2] The 1991 Amendments to Rule 52 are not applicable to this case because of the prior date of action by the district court. However, notwithstanding the prior date of action by the district court, the changes made by the 1991 Amendments to Rule 52 would not affect any issue raised by this case.

[3] J.I.T., Dennis Foy, and Charles Baughman are additional parties below but did not participate in the appeal,

(continued...)

Prior to that purchase, Ropak performed due diligence inquiries into the various products it was acquiring from J.I.T., and was aware of a Consent Judgment and a contemporaneous Settlement and License Agreement which had been entered in July, 1988. The Consent Judgment concerned, among other things, infringement of Xytec's U.S. Pat. No. 4,674,647 ("the '647 patent") which is the present patent in suit, and was directed to a J.I.T. bin known as the J.I.T. 4000. Pursuant to the Settlement and License Agreement, Xytec licensed J.I.T. to manufacture bins under the '647 patent.

In its due diligence inquiries, Ropak also confirmed that, on or before the entry of the Consent Judgment, J.I.T. had ceased its production of the J.I.T. 4000 bins and had modified all of its bin molds (including specifically the corner joint construction which is the focus of the '647 patent) to produce bins which, in the opinion of J.I.T.'s patent counsel, did not infringe the '647 patent. In the negotiations which led to the Consent Judgment, counsel for J.I.T. had advised Xytec's counsel of these pending modifications of J.I.T.'s bins, to which Xytec's counsel replied that Xytec would have to file a Reissue application in order to obtain claims covering the modified construction.[4]

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[3](...continued)
as the preliminary injunction which is the subject matter of the appeal by Ropak was not entered as to these parties.

[4] Xytec has indeed filed a Reissue application which is still pending before the United States Patent and Trademark Office. In that proceeding, the patent claims upon which the grant of injunctive relief by the district court were based have been *rejected* as unpatentable. As of the time of filing
(continued...)

In the current lawsuit, these initially modified versions of the J.I.T. 4000 bin were designated as the 4000 Series II(A) and (A') bins. Prior to its purchase, Ropak received an opinion from J.I.T.'s patent counsel that the Series II(A) and (A') bins did not infringe the '647 patent. None of the relevant assets purchased by Ropak involved the original bins which were the subject matter of the prior lawsuit or the Settlement and License Agreement.

About February, 1990, prior to any allegation of infringement, Ropak made additional engineering changes to the 4000 Series II(A) and (A') bins to a construction which has been designated in the instant lawsuit as the 4000 Series II(B) bins.

Subsequent to its May, 1989 purchase, Ropak introduced an additional bin corner construction to the market: the Delta or Dovetail corner bin. Ropak has its own U.S. Pat. No. 4,917,255 covering the Dovetail collapsible bin. Since February, 1990, Ropak has manufactured only the Dovetail bins and the twice-modified 4000 Series II(B) bins, and has never manufactured or sold the bins which were the subject of the Consent Judgment.

Contemporaneously with Ropak's purchase in May, 1989, J.I.T. notified Xytec that Ropak had purchased the relevant bin-manufacturing assets of J.I.T. In addition, J.I.T. forwarded the remaining minimum royalty payment due under the Xytec/J.I.T. Settlement and License Agreement and canceled that Agreement pursuant to the terms

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[4](...continued)
this petition, prosecution of these rejected claims continues and rejection of these claims by the United States Patent and Trademark Office is still outstanding, although not final.

thereof, specifically advising Xytec that the modified Series II (A) and (A') bins (the only bins then being produced) did not infringe the '647 patent.

Notwithstanding the aforementioned substantial modifications in the 4000 Series II(B) bins, and notwithstanding the tremendous differences between the corner structure disclosed in the '647 patent and that utilized in Ropak's patented Dovetail bins, Xytec finally sued Ropak in September, 1990 -- almost one-and-one-half years after learning of Ropak's entry into the market -- and contemporaneously filed a motion for preliminary injunction.

In November, 1990, the district court conducted an abbreviated hearing on Xytec's motion for preliminary injunction. In the hearing, Ropak and Xytec were each limited to one hour and ten minutes of direct examination, and no closing argument was had. At the hearing, Xytec presented evidence *only* regarding the original J.I.T. 4000 bins, the discontinued 4000 Series II(A) bins, and the Dovetail bins. Xytec knew of but did *not* present any evidence regarding the Series II(B) corner construction.

At the end of the hearing on Xytec's motion for preliminary injunction, the Court stated, and Xytec's counsel agreed, that there did not appear to be any substantial urgency in the situation which would require an immediate ruling from the Court:

> "THE COURT: Do either counsel believe that a decision at the conclusion of tomorrow's session [on November 30, 1990] would be imperative?
>
> . . .

MR. ANTHONY: Within a reasonable time thereafter would be fine, Your Honor."

On February 15, 1991, the district court issued its decision, preliminarily enjoining Ropak from the manufacture and sale of all of its collapsible bins, including the 4000 Series II(B). On the morning of the next court day, Ropak filed a notice of appeal and a motion to stay the preliminary injunction based upon errors and *omissions* in the findings of the district court. Xytec filed a responsive pleading, and a hearing, including the first oral argument on the issues, was held on the following morning.

At the close of oral argument, the district court ordered that the preliminary injunction be stayed during the pendency of Ropak's appeal, on the conditions that Ropak post a $500,000 bond and file monthly sales reports with the district court and with Xytec's counsel. Among other things, the district court stated that, "The [patent infringement] issue was technical and, in the judgment of the Court, the question of infringement was a close one. . . ."

The Court of Appeals denied Xytec's subsequent motion to lift the stay. After briefing by the parties, oral argument was had by the Court of Appeals on September 11, 1991, and on January 8, 1992, the Court of Appeals affirmed the issuance of the preliminary injunction.

The Court of Appeals effectively held that a preliminary injunction need not be supported by affirmatively demonstrated findings of fact by the trial court. Ropak's Petition for Rehearing was denied on February 18, 1992, and the mandate issued on February 25, 1992.

The preliminary injunction issued in this lawsuit was based solely on the doctrine of equivalents infringement analysis, rather than literal infringement. The United States Court of Appeals for the Federal Circuit has consistently held that, in making a doctrine of equivalents analysis, the scope of equivalents covered by a patent may not be expanded so broadly as to cover the prior art. Yet while prior art was admitted into evidence, the district court failed to cite or analyze a single piece of that prior art *and did not make any findings with respect thereto*. But the Court of Appeals responded to your petitioner's argument that this was error by holding that Ropak was required to show that the court *actually failed* to considered the prior art. This is an impossible standard and is inconsistent with the requirements of Rule 52(a).

REASONS FOR GRANTING THE WRIT

I. Certiorari is Necessary to Correct the Court of Appeals' Clear Error on a Matter of National Importance

This is not just an ordinary patent case. It involves the interpretation of the Federal Rules of Civil Procedure that will have, unless reversed, a significant negative impact on standards for preliminary injunction proceedings in all cases in the federal courts of the United States. When this Court issued and Congress accepted Rule 52 as part of the Federal Rules of Civil Procedure over fifty years ago, it intended to create a standard of judicial findings upon which the public could rely. The purpose of Rule 52(a) was to adopt in the federal courts in actions tried upon facts without a jury the prevailing equity practice which permitted review

and reversal of findings of fact in the interest of seeing that justice was done.[5]

Much of the subsequent history of Rule 52 has been focused upon consideration of the scope of appellate review where the case under review involves documentary evidence as opposed to oral evidence.[6] This Court has determined that the applicable standard of Rule 52(a) review is a "clearly erroneous" standard. *United States v. United States Gypsum Co.*, 333 U.S. 364 (1948). However, in order that any meaningful review be possible under Rule 52, all decisions must have "findings of fact and conclusions of law which constitute the grounds of its action" set forth by the district court. In this case, the Court of Appeals accepted the conclusions of the trial court without the findings of fact necessary to support the injunction being set forth. This is error.

Because all appeals concerning patent matters are within the exclusive appellate jurisdiction of the Federal Circuit pursuant to 28 U.S.C. § 1295, the failure to follow the dictates of the Federal Rules will irretrievably effect federal law practiced throughout the United States in a manner never anticipated by Congress if this Court does not grant certiorari now. This is so because Rule 52 is directed to proceedings by the various district courts. By lowering the standards of Rule 52 procedures, the Court of Appeals

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[5] *See:* Notes of Advisory Committee on Rule 52 for the 1937 Adoption.

[6] *See:* Application of "Clearly Erroneous" Test of Rule 52(a) of Federal Rules of Civil Procedure to Trial Court's Findings of Fact Based on Documentary Evidence: Annot., 11 ALR Fed 207 (1972).

has accepted a practice whereby the appropriate basis for decisions of the trial court cannot be clearly determined. Such lowering of the standards is in error and inconsistent with the requirements of this Court.

In rendering the decision complained of in this petition the Court of Appeals has ignored its own recent factually-indistinguishable decision of *We Care, Inc. v. Ultra-Mark, Int'l. Corp.*, 930 F.2d 1567, 18 USPQ2d 1562 (Fed. Cir. 1991), wherein the Court of Appeals vacated and remanded a preliminary injunction where the district court did not adequately consider whether the range of equivalents sought by the patentee would "ensnare the prior art".

This Court should grant certiorari for several persuasive reasons discussed in detail below.

This Court has granted certiorari in cases decided by the Federal Circuit when important statutory issues were raised, and Congress clearly intended that such access to this Court would be available. *See, e.g., Cornelius v. Nutt*, 472 U.S. 648 (1985); H.R. Rep. No. 312, 97th Cong., 1st Sess. 18-19 (1981). The Court of Appeals' egregious error and the substantial adverse effect of that error on federal procedure make this case appropriate for review by this Court.

The Court of Appeals wrongly acted by ignoring the very standards upon which it must conduct its review. Absent redress by this Court, the Court of Appeals will continue ignoring the mandatory standards of review.

II. The Court of Appeals' Decision is Directly Contrary to the Language of the Rule, Legislative History and Case Law

An examination of Rule 52(a) discloses that its objective is to have the trial court set forth findings of fact and conclusions of law in cases where the court is the trier of fact, when decision turns in full or in part upon a factual determination. In *United States v. United States Gypsum Co.*, 333 U.S. 364 (1948) this Court set forth the scope of appellate review under Rule 52(a):

> That rule prescribes that findings of fact in actions tried without a jury 'shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses.' It was intended, in all actions tried upon the facts without a jury, to make applicable the then prevailing equity practice. Since judicial review of findings of trial courts does not have the statutory or constitutional limitations of findings by administrative agencies or by a jury, this Court may reverse findings of fact by a trial court when 'clearly erroneous.' . . . The findings were never conclusive, however. A finding is 'clearly erroneous' when although there is evidence to support it, the reviewing court on the entire evidence is left with the definite and firm conviction that a mistake has been committed. [All Citations Omitted]

Under Rule 52(a), where the trial court fails to make findings or to find on a material issue, and an appeal is

taken, the appellate court should vacate the judgment and remand the action for appropriate findings to be made. *Pullman-Standard v. Swint*, 456 U.S. 66 (1982) In this case, the Court of Appeals did not do so.

A. The Court of Appeals Turned Rule 52 on Its Head

By ignoring the requirements of Rule 52(a), the Court of Appeals has set the stage for impending chaos in the federal courts, and consequently in the matters determined by those courts. This is especially true with respect to patent matters, on which the district courts look exclusively to the Federal Circuit for guidance. District courts will be granted a wholesale license to issue orders and judgments without a modicum of factual support. Courts of appeal will be tempted and permitted to affirm the district courts in any circumstance in which the courts of appeal "suspect" that the district court made a proper analysis, regardless of whether the district court gives any indication of even understanding what analysis is required for a given legal issue.

The preliminary injunction in this lawsuit was based solely on the doctrine of equivalents infringement analysis, rather than literal infringement. The Court of Appeals acknowledged this in its affirmance of the preliminary injunction. [Pet.App. A6-8].

The Court of Appeals has consistently held that, in making a doctrine of equivalents analysis, the scope of the equivalents covered by the patent may not be expanded so broadly as to cover the prior art. For example, the Court of Appeals has stated that, in the ordinary patent case, the trier of fact must answer factual inquiries relating to, among other

things, the scope and content of the prior art, and differences between the prior art and the claims at issue. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1547, 220 USPQ 193 (Fed. Cir. 1983).

Although relevant prior art was admitted into evidence at the preliminary injunction hearing, the district court failed to cite or analyze a single piece of that prior art. Indeed, nowhere in the district court's preliminary injunction is the concept of prior art discussed or even mentioned.

The Court of Appeals justified this failure of the district court by reversing the burden of proof of Rule 52(a) that there be "findings of fact ... which constitute the grounds of its action", and imposing an impossible burden upon your petitioner: the Court of Appeals stated that "Ropak fails to show that the court actually failed to examine the prior art." [Pet.App. 7a]

Under Rule 52, it is impermissible for the Court of Appeals to require that *petitioner show what was in the trial court's mind;* for the standard is that the *trial court must set forth the bases* in fact and law which constitute the grounds of its action.

While under Rule 52(a) a strong presumption exists in favor of the trial court's finding of fact[7] and the burden of proof is on the party attacking validity, that burden relates *only* to the findings which the court has *set forth* in *establishing* the grounds for its decision, and *not* to matters which the court did not address.

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[7] *Smith v. James Irvine Foundation*, 402 F.2d 772 (9th Cir. 1969), *cert. denied*, 394 U.S. 1000 (1969)

In summary, the law requires that the district court make certain findings -- here, regarding the prior art. The district court made no such findings. How can your petitioner attack the validity of such "non-existent" findings? It is impossible.

Under the applicable patent law, the finding of equivalence is a determination of fact and it must be based upon the scope and content of the prior art. *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605 (1950). Here the Court of Appeals refused to require that an injunction be based upon the factual considerations of the art. Indeed, it refused to acknowledge that the prior art need be considered. It is clear that the district court made no findings of fact respect to the prior art *because it did not consider the prior art*. Because this is a legal requirement for injunctive relief of the scope granted here, the action of the court was in error.

B. The Court of Appeals Imposed an Impossible Burden on Ropak

In affirming the preliminary injunction, the Court of Appeals improperly imposed the burden on Ropak to "show that the [district] court actually failed to examine the prior art." [Pet.App 8] To impose such a burden on Ropak would turn Rule 52 on its head; rather than the district court being required to adequately articulate its findings, Ropak was required by the Court of Appeals to prove a negative. Such a standard is impossible, and is contrary to the requirements of the Federal Rules and of due process.

The "vacuum" of the District Court's opinion created the impossibility. The district court not only failed to

consider and apply the prior art made of record by Ropak, *it failed to even mention the concept of prior art at all.* Such a complete absence of discussion cannot evidence anything but the district court's failure to examine the prior art. What else could Ropak do but point to the district court's complete silence as to the prior art? What better evidence can there be that the district court did not consider the prior art?

Litigants are not empowered to "reach behind" the orders of the district courts. The focus and purpose of Rule 52(a) is to eliminate the need to "reach behind" those orders and to also eliminate the need to "suspect" what the district court did or did not do.

The Court of Appeals even acknowledged at the oral argument that there was nothing in the district court's opinion or judgment that confirms that the trial judge looked at the prior art and the prosecution history. Regardless of what the Court of Appeals "suspected" that the district court may have done, Rule 52 requires a finding on that issue. Such a finding, as the Court of Appeals acknowledged, was not present in the district court's opinion or judgment.

Ropak respectfully submits that, if the Court of Appeals' decision is permitted to stand based on the reviewing court "suspicions" rather than on an articulated finding, Rule 52 is rendered meaningless, in this case and in any case. The rule of law will be obliterated, and the rule of man will rise in its place: a district court will be permitted to reach any decision without articulating the bases for that decision.

C. The Federal Circuit Has Negated its Central Purpose: Uniformity of the Patent Law

The Federal Circuit was created in 1982 by the Federal Courts Improvements Act of 1982, Pub. L. 97-164, 96 Stat. 25. According to the legislative history of that Act, its central purpose was to" . . . reduce the widespread lack of uniformity and uncertainty of legal doctrine that exist in the administration of patent law" (H.R. Rep. 97-312, 97th Cong., 1st Sess. 23) and to provide:

> "[a] forum that will increase doctrinal stability in the field of patent law. Based on the evidence it had compiled, the Hruska Commission singled out patent law as an area in which the application of the law to the facts of a case often produces different outcomes in different courtrooms in substantially similar cases. Furthermore, in a Commission survey of practitioners, the patent bar indicated that uncertainty created by the lack of national law precedent was a significant problem....
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> ...
>
> "The testimony received by the committee also supported the basic objective of providing for uniformity of doctrinal development in the patent area....
>
> ...
>
> "The creation of the Court of Appeals for the Federal Circuit will produce desirable uniformity in this area of the law." S.Rep. 97-275, 97th Cong., 1st Sess. 5, reprinted in 1982 U.S. Code Cong. & Ad. News 15.

The Federal Circuit itself has acknowledged that it was "created, as contemplated by the Congress, to achieve uniformity and to reduce uncertainties in this area", and that it thus "has a mandate to achieve uniformity in patent matters." *Panduit Corp. v. All States Plastic Mfg. Co.*, Inc., 744 F.2d 1564, 223 USPQ 465, 470-71 (Fed. Cir. 1984).

In this case, the Federal Circuit has fallen far short of complying with that mandate. The instant case is factually indistinguishable decision from *We Care, Inc. v. Ultra-Mark, Int'l. Corp.*, 930 F.2d 1567, 18 USPQ2d 1562 (Fed. Cir. 1991), in which the Court of Appeals vacated and remanded a preliminary injunction where the district court did not adequately consider whether the range of equivalents sought by the patentee would "ensnare the prior art". *We Care*, 18 USPQ2d at 1564.

The only distinction between this case and *We Care* is that this case involves an even more egregious lack of analysis of infringement! Ropak submits that, in view of the similarities between *We Care* and this case, the law cannot be so arbitrary as to support reversal in *We Care* and affirmance in this case.

In *We Care*, the Court of Appeals expressly identified appropriate steps a district court must take in applying the doctrine of equivalents. Because the *We Care* district court did not take all of those steps, its analysis was fatally flawed and resulted in a vacation and remand of the preliminary injunction. Among other things, the Court of Appeals stated in *We Care* that:

> [E]quivalency [under the doctrine of equivalents] is determined *in the light of prior art,*

the patent specification, and the prosecution history, as the accused systems are tested by the standards set forth in *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.* . . . In *Wilson Sporting Goods, Co.*, the court explained precisely how the prior art restricts the range of equivalents, as follows:

> A patentee should not be able to obtain, under the doctrine of equivalents, coverage which he could not lawfully have obtained from the PTO by literal claims. The doctrine of equivalents exists to prevent a fraud on a patent [citations omitted], not to give a patentee something which he could not lawfully have obtained from the PTO had he tried. Thus, since prior art always limits what an inventor could have claimed, it limits the range of permissible equivalents of a claim [citations omitted].

Thus, a determination of infringement based on this doctrine cannot be made in a vacuum; the prior art must be examined to assure that the range of equivalents asserted by the patent holder does not encroach upon subject matter in the prior art. [citations omitted]. This, of course, involves consideration of what the prior art would have anticipated, 35 U.S.C. 102, and what the prior art would have made

> obvious, 35 U.S.C. 103, when the patentee filed the original application. In this way, the doctrine of equivalents is limited; it may not be used to extend a patent holder's right to exclude beyond what could lawfully have been obtained in an original application. [citations omitted]. 18 USPQ2d at p. 1564-65 (emphasis in original).

The *We Care* district court had compared eight prior art patents with the asserted patent Claim 1, and had found that none of them identically showed every element of the claim. The Court of Appeals held that the district court had not gone far enough because the court "had failed to consider whether the teachings of these eight patents would have made obvious the range of equivalents afforded the [patent] claims." On that basis, this Court vacated the preliminary injunction and remanded the case to the district court to determine whether the range of equivalents encroaches upon the prior art. *We Care*, 18 USPQ2d at p. 1565.

In the instant case, the district court did not compare *any* of the prior art to the asserted range of equivalents, either for anticipation or obviousness inquiries. *A fortiori*, the preliminary injunction in this case should at least be vacated and the case remanded for further findings in this regard.

Identically to the accused products in *We Care*, Ropak's Series II and Dovetail bins had never been charged with infringement prior to the instant lawsuit. Also identically to the alleged infringer in *We Care*, Ropak contended in the district court that Xytec's '647 claims could not be granted a range of equivalents covering Ropak's bins without also covering one or more prior art devices.

Based on the Court of Appeals' precedent such as *We Care*, the district court was required to consider anticipation and obviousness issues in determining the range, if any, of equivalents to which Xytec's '647 patent was entitled. As noted below and in Ropak's previous pleadings and argument in this appeal, had the district court made the required analysis of the range of equivalents, it could only have determined that such scope could not cover Ropak's bins.

The district court in the instant case did not even make the analysis determined to be insufficient by the Federal Circuit's *We Care* decision. Indeed, even if the district court had made the *We Care* analysis, the Court of Appeals should have vacated and remanded in order to fulfill the court's mandate that it establish uniformity in the patent law. The Federal Circuit failed to comply with its mandate of uniformity by refusing to follow *We Care* and its other decisions.

The Court of Appeals' failure to consider the instant case in the manner of the *We Care* standards demonstrates that the appellate court failed to follow the law of Rule 52(a) as established by this Court in *United States v. General Motors Corp., 384 U.S. 127 (1966).*

In *United States v. General Motors Corp. supra*, this Court held that the district court's ultimate conclusion on defendants' conduct was not to be shielded by the "clearly erroneous" test embodied in Rule 52(a). Like the instant case, the critical finding in the *General Motors* case was not one of "fact" but consisted rather of the legal standard required to be applied to the facts on the case. The critical findings here relate to the legal standard of what must be considered to determine infringement, namely, consideration of the prior art and the file prosecution history. Like the

decision of the *General Motors* district court, the decision of the trial court below should not be shielded from review for it did not make the proper findings which could support its decision.

D. Counsel Cannot Waive The Provisions of Rule 52(a)

Ropak has consistently maintained that a proper application of the doctrine of equivalents could not encompass Ropak's bins. The record in this case supports Ropak's position and mandated that the district court address this matter expressly, pursuant to Rule 52(a). It did not and Court of Appeals failed to recognize this to be an essential requirement for orders and injunctions in cases without a jury.

One reason that the Court of Appeals apparently felt comfortable in ignoring the requirements of Rule 52(a) in its review of the district court action was its apparent belief that "counsel for Ropak conceded that there was enough evidence in the record before the district court for it to find that Xytec would likely prevail at trial on the question of infringement." [Pet.App. 5a] Upon a review of the transcript of the hearing, counsel for Ropak could find no "concession" on this point in the oral argument and it was upon this fact that a request for rehearing was made below. As a part of that request, a transcript of the oral argument was submitted to show that no such concession was made.

Ropak's counsel has never conceded the very fact in controversy here either before the trial court or the Court of Appeals. What was under review by the Court of appeals was the decision of the trial court which did *not* make the

necessary findings of facts and conclusions of law as are necessary to render proper a preliminary injunction in this case as required by Rule 52(a). No concession could overcome the record on this point and none was made.

The ultimate and only tests as the adequacy of findings is whether they are sufficiently comprehensive and pertinent to the issue to form a basis for the decision and whether they are supported by the evidence.[8] The issue is what the district court found, and any suppositions as to what counsel may or may not have said can have no impact on the mandate of Rule 52(a) that the trial court is required to state the basis for its decision.

The duty imposed by Rule 52 cannot be affected by agreement between counsel waiving finding. *Berguido v. Eastern Air Lines, Inc.* 369 F.2d 874 (3rd Cir. 1966). Just as the requirement for *stated findings* by the trial court cannot be waived by agreement of counsel, it cannot be compromised by any statements made by counsel.

III. An Important Federal Procedural Issue Is Before This Court

This case raises a federal procedural issue of exceptional importance. If a preliminary injunction can be supported without meeting the formal requirements of Rule 52(a), significant confusion will erupt about the basis and appropriateness of equitable relief granted by the courts. Absent instruction from this Court, the Court of Appeals will

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[8] *Fluor Corp. v. United States ex rel Mosher Steel Co.*, 405 F.2d 823 (9th Cir. 1969), *cert. denied*, ___ U.S. ___, 23 L.ed2d 40 (1970).

foreseeably continue to ignore Rule 52(a). This failure to make a complete record in support of judicial action is significant.

The Court of Appeals' decision will wreak havoc on the judicial system. It will remove any incentive for the district courts to make complete records and will render judicial review of such records impossible. The oft stated principle of appellate review which the Court of Appeals used here, namely, "We review judgments and orders, not the particular language with which the trial court chose to express itself" [Pet.App. 5], is meaningless if the judgment or order does not include those findings of fact and conclusions of law necessary to demonstrate the appropriateness of the action taken by the trial court.

CONCLUSION

For the reasons set forth above, Ropak respectfully petitions for a review on writ of certiorari.

The Court of Appeals turned Rule 52(a) on its head by requiring that *petitioner Ropak* "show that the [district] court actually failed to examine the prior art" when the standard is the district court must make findings of fact regarding the "prior art." Both the rule and the decisional law regarding the rule are clear that finding of facts are necessary to aid appellate review and must be made. The district court's failure to even mention the prior art left a "vacuum" on that critical issue. Justice cannot operate in a vacuum.

The Federal Circuit violated its self-acknowledged "mandate to achieve uniformity in patent matters," by

issuing a decision directly contradictory to its prior decisions. Moreover, it has ignored both the language and spirit of Federal Rule 52 which establishes a standard for judicial findings in proceedings.

For the foregoing reasons, this petition for certiorari should be granted. Because the Court of Appeals' decision is so clearly erroneous, summary reversal is appropriate.

Respectfully submitted,

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APPENDIX

APPENDIX

Page

Court of Appeals Opinion 1a

Court of Appeals Decision on Rehearing 11a

Court of Appeals Judgment and Mandate 12a

Rule Involved 13a

United States Court of Appeals for the Federal Circuit

91-1206

XYTEC PLASTICS, INC.,

Plaintiff-Appellee,

v.

ROPAK CORPORATION,

Defendant-Appellant.

DECIDED: January 8, 1992

Before ARCHER, MICHEL, and PLAGER, *Circuit Judges*.

MICHEL, *Circuit Judge*.

Xytec Plastics, Inc. is the owner of U.S. Patent No. 4,674,647 (the '647 patent), which is directed to collapsible containers used mostly in the auto assembly business. Ropak Corporation appeals from the order of the United States District Court for the Eastern District of Michigan, Southern Division, preliminarily enjoining Ropak from infringing the '647 patent. *Xytec Plastics, Inc. v. Ropak Corporation*, Civil Action No. 90-CV-72707 (Feb. 15, 1991). Because Ropak has not shown that the trial court abused its discretion in granting the preliminary injunction, we *affirm*.

BACKGROUND

Xytec and Ropak manufacture and distribute competing collapsible storage containers. Ropak entered the collapsible container market in May, 1989, through its acquisition, as to all assets relevant to making such containers, of J.I.T. Corporation. At the time of the purchase, Ropak was aware of the Settlement and License Agreement ("Agreement") and related Consent Judgment entered in July, 1988, in an infringement suit between J.I.T. and Xytec. Under the Consent Judgment, J.I.T. acknowledged the validity of the '647 patent and infringement by J.I.T.'s Model 4000 container. But the Agreement gave J.I.T. a license to manufacture containers within the scope of the claims of the '647 patent. When Ropak acquired J.I.T., J.I.T. had terminated the Agreement with Xytec, alleging that its modifications to the Model 4000 container[1] avoided infringement of the '647 patent. The Consent Judgment, however, remained.

Later, Ropak further modified the Model 4000 container, and the parties have designated the twice-modified container as the Model 4000 Series II(B) container. Ropak also manufactured and distributed a "delta" container.

Xytec commenced the underlying action against Ropak in September, 1990, and thereafter moved for a preliminary injunction. After a three-day hearing, the district court found that Xytec had established a reasonable likelihood of success on the merits, irreparable harm, a balance of hardships in its favor, and that the preliminary injunction is in the public interest. *See Hybritech Inc. v. Abbott Laboratories*, 849 F.2d 1446, 1451, 7 USPQ2d 1191,

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[1] Ropak refers to the J.I.T.-modified containers as the Model 4000 Series II(A) and (A') containers.

1195 (Fed. Cir. 1988). Thus, the lower court granted Xytec's motion,[2] but on February 26, 1991, stayed the preliminary injunction pending the present appeal.

We have and exercise jurisdiction pursuant to 28 U.S.C. §§ 1292 (c)(1), 1295(a)(1), and 1338 (1988).

DISCUSSION

We will not disturb a preliminary injunction on appeal unless the district court has "abused its discretion, committed an error of law, or seriously misjudged the evidence." *Smith Int'l, Inc. v. Hughes Tool Co.*, 718 F.2d 1573, 1579, 219 USPQ 686, 691 (Fed. Cir.) (citing *Eli Lilly & Co. v. Premo Pharmaceutical Labs*, 630 F.2d 120, 136, 207 USPQ 719, 734-35 (3d Cir. 1980)), *cert. denied*, 464 U.S. 996, 220 USPQ 385 (1983). None of the four traditional factors concerning preliminary injunctions is dispositive. Instead, we must examine the record to see if the district court committed reversible error in its net evaluation of *all* the *Hybritech* factors. *See Chrysler Motors Corp. v. Auto Body Panels of Ohio, Inc.*, 908 F.2d 951, 953, 15 USPQ2d 1469, 1471 (Fed. Cir. 1990); *Hybritech*, 849 F.2d at 1451, 7 USPQ2d at 1195 ("[T]he district court must weigh and measure each factor against the other factors and against the form and magnitude of the relief requested.") (footnote omitted).

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[2] The preliminary injunction apparently affects only the Model 4000 Series II(B) and delta containers because, according to the appellant, Ropak had discontinued the Model 4000 Series II(A) and (A') by the time of the lower court's order. Our analysis is correspondingly limited.

I. Likelihood of Success on the Merits

Both in its principal brief and in its reply brief, Ropak dwells on alleged shortcomings of the lower court opinion, including the district judge's failure to refer to the specification or prosecution history in interpreting the claim,[3] Appellant's br. at 16, and its failure to discuss the prior art in establishing the permissible scope of equivalents, *id.* at 17, 20, Reply br. at 9. Indeed, Ropak entitles a portion of its reply brief, "V. EVEN IF THE DISTRICT

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[3] Claim 12 of the '647 patent reads as follows:

A container comprising in combination; base means providing a container floor, an opposing pair of side and an opposing pair of end walls, hinge means pivotally connecting said side and end walls to said base means with the side and end walls being pivotal between an upright position and a collapsed folded position disposed over said floor, mating engagement means on the respective adjacent pairs of side edges of said side and end walls for preventing said walls when in their upright position from pivoting outwardly beyond the vertical when engaged, said mating engagement means including for an adjacent pair of said edges presented by a pair of adjacent side and end walls a flange extending along the side edge of the end wall projecting away from the inner face of the end wall and a flange extending along the side edge of the side wall projecting inwardly from the edge of the side wall and in parallel spaced relation to the inner face of the side wall, said flanges interfitting to become engaged with the side and end walls moving from their collapsed to their upright position, and means on said mating engagement means preventing relative longitudinal movement of the respective edges having said flanges when the flanges are engaged.

COURT IS DEEMED TO HAVE ATTEMPTED A LITERAL INFRINGEMENT ANALYSIS, ITS *OPINION* SHOULD BE REVERSED." Reply br. at ii, 20 (emphasis added). Finally, at oral argument, counsel for Ropak conceded that there was enough evidence in the record before the district court for it to find that Xytec would likely prevail at trial on the question of infringement.[4] The only error with respect to this issue that appellant argues is the lower court's failure to discuss the prosecution history and prior art explicitly.

In all of these ways, the appellant has ignored our oft-repeated position that "[w]e sit to review judgments, not opinions." *E.g.*, *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1540, 218 USPQ 871, 880 (Fed. Cir. 1983). Although faulty reasoning but also an incorrect result, an appellant must show not only faulty reasoning but also an incorrect result. *Union Carbide Corp. v. American Can Co.*, 724 F.2d 1567, 1573-74, 220 USPQ 584, 589-90 (Fed.Cir. 1984). We review judgments and orders, not the particular language with which the trial court chose to express itself.

Applying this principle to the instant case, appellant fails to explain both why the district court finding of Xytec's likelihood of success on the infringement issue was error and how such error led to an incorrect result, *i.e.*, the issuance of a preliminary injunction. Appellant concedes, and we have no reason to conclude otherwise, that there was enough

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[4] Ropak does not challenge the lower court's application of state law holding that the Consent Judgment binds Ropak because of its *de facto* merger with J.I.T. As a result, Ropak may not litigate the validity of the '647 patent. Thus, we review the district court finding in favor of Xytec of reasonable likelihood of success only as to infringement.

evidence before the district court to support its finding. By itself, the basis of prediction the lower court relies on to make the finding that Xytec will likely succeed on the infringement issue at trial cannot constitute reversible error where the evidence is sufficient. Nor is there any indication of an abuse of discretion in the district court's evaluation of the record evidence as to infringement compared to the evidence on the other *Hybritech* factors.

Similarly, we discern no legal error in the district court's interpretation of the scope of claim 12 and no clear error in its application of the doctrine of equivalents.[5] An accused product may infringe a patent claim under the doctrine of equivalents if it "performs substantially the same overall function or work, in substantially the same way, to obtain substantially the same overall result as the claimed invention." *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 934, 4 USPQ2d 1737, 1739 (Fed. Cir. 1987) (*in banc*), *cert. denied*, 485 U.S. 961 (1988). The purpose of the doctrine of equivalents is to allow a finding of infringement where the accused product does not literally meet every limitation of a patent claim but does contain the legal equivalent thereof. Such a finding is a factual determination reviewable for clear error. *Insta-Foam Prods., Inc. v. Universal Foam Sys., Inc.*, 906 F.2d 698, 702, 15 USPQ2d 1295, 1297 (Fed. Cir.) (citations omitted), *reh'q denied*, 1990 U.S. App. LEXIS 15190 (Fed. Cir. 1990).

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[5] The judge who issued the preliminary injunction also presided over the prior litigation between J.I.T. and Xytec which ended in the entry of the Consent Judgment. Thus, the judge already was familiar with the collapsible container art in general and the Xytec '647 patented container in specific.

Ropak contends that the district court did not find every element of the claim or its substantial equivalent in appellant's containers. In particular, Ropak points to the absence of the "flange extending along the side edge" and "means on said mating engagement means preventing relative longitudinal movement of the respective edges" in the accused containers. Appellant's br. at 28. With respect to the 4000 Series II containers, the district court found that the "flange construction at the corners: was the only difference from the container disclosed in the '647 patent but that the various flanges performed "the exact same function" and have similar engagement structures. Order at 7-8. Turning to the delta container, it found "the minor differences in the design are inconsequential" and specifically that the engagement means are "fully functional equivalents" to those disclosed in the '647 patent. Order at 8. Thus, for purposes of the preliminary injunction motion, the court found Ropak's containers infringe the '647 patent under the doctrine of equivalents because "the 4000 Series II bins and the Delta bin incorporate features which function in substantially the same way to produce a result that is identical to the claims of the 647 patent." Order at 13. Although the court did not address the issue of preventing longitudinal motion, given the record, the finding is not clear error.

Ropak also argues that the lower court neglected to consider the prior art in construing the permissible range of equivalents. But Ropak fails to show that the court actually failed to examine the prior art. Nor is the import of the prior art so clear as to compel us to infer that the district court neglected to consider the prior art at all in its analysis of infringement under the doctrine of equivalents.

Another factor indicating Xytec;s likelihood of success ont he infringement issue is the Consent Judgment. Referring to the Consent Judgment, the lower court stated, "this Court must recognize the efficacy of its earlier ruling

and conclude that Xytec has an excellent chance, albeit rebuttable, of proving patent infringement." Order at 10. Ropak has not argued that this approach is an abuse of discretion or legal error.

During appellant's motion for a stay, the lower court commented, "the question of infringement was a close one, but . . . the Court believed and continues to believe that Xytec's position was violated by Ropak." Joint App. at 474. Even if the finding of reasonable likelihood of success on the infringement issue is a close call, it is nevertheless well within the range of discretion of the district court as the fact-finder; on the record before us, we cannot say the finding is clearly erroneous.

II. Irreparable Harm

In *Smith*, we held "that where validity and continuing infringement have been clearly established . . . immediate irreparable harm is presumed. To hold otherwise would be contrary to the public policy underlying the patent laws." *Smith*, 718 F.2d at 1581, 219 USPQ at 692-93 (footnote omitted). We explained the holding in a footnote:

> Our holding on this issue does not abrogate the traditional requirement of a showing of irreparable harm by one seeking a preliminary injunction. . . . [T]he trial court should balance the requisite factors. In cases where the showing of validity and infringement is less forceful than it is here, or in cases where equitable or public policy considerations are in favor of the infringer, a movant would have to make a stronger showing of irreparable harm in order to tip the balance of equity in his favor.

Id at n.7, 219 USPQ at 692 n.7.

On appeal, Ropak argues that the district court committed reversible error by applying the *Smith* presumption of irreparable harm because Xytec did not make a strong enough showing of validity and infringement. The appellant misconceives the holding of *Smith*. The language of *Smith* makes it plain that the degree to which a movant may continue to rely on such a presumption to obtain a preliminary injunction is a function of the strength of its showing with respect to the other three *Hybritech* factors. Contrary to Ropak's argument, *Smith* does not stand for the proposition that the irreparable harm presumption never arises absent clearly established validity and continuing infringement. Thus, the mere fact that the lower court applied the presumption is not legal error. Admittedly, the *strength* of that presumption, and by implication whether to grant a preliminary injunction, must be viewed in light of other *Hybritech* factors. To the extent the trial court relied on *Smith*, there is no language in its order to suggest that the irreparable harm presumption, by itself, was dispositive of the motion. Indeed, the court's careful analysis of the proof of infringement under the doctrine of equivalents precludes such an interpretation of its order. Clearly, the presumption was only one factor that the district court weighed.

III. Balance of Private Harms and the Public Interest

Each party presented evidence of financial harm it may suffer. Xytec also argued compromise of its competitive position as a harm it would suffer without a preliminary injunction. Particularly since Ropak only recently entered the collapsible container market and did so through the acquisition of a proven infringer, Ropak fails to show how the district court seriously misjudged opposing evidence of

hardship. Such balancing of hardships is committed to the sound discretion of the district court, and we cannot say its finding was clearly erroneous.

Finally, Ropak does not and could not deny that the preliminary injunction serves the public interest if Ropak is infringing a valid patent. In the absence of countervailing evidence and because Ropak is bound by J.I.T.'s concession of validity, the district court did not clearly err in finding the public interest supports granting the motion.

CONCLUSION

The district court did not commit reversible error when it interpreted the patent claim and applied the doctrine of equivalents in finding likelihood of infringement. Moreover, it expressly considered and conscientiously balanced all four *Hybritech* factors. There is ample evidence in the record to support the district court findings, and it did not otherwise abuse its discretion. Accordingly, the order granting the preliminary injunction motion is affirmed.

United States Court of Appeals for the Federal Circuit

91-1206

XYTEC PLASTICS, INC.,

Plaintiff-Appellee,

v.

ROPAK CORPORATION,

Defendant-Appellant.

ORDER

Before ARCHER, Circuit Judge, MICHEL, Circuit Judge, and PLAGER, Circuit Judge.

A petition for rehearing having been filed in this case, UPON CONSIDERATION THEREOF, it is ORDERED that the petition for rehearing be, and the same hereby is, denied.

The mandate will issue on February 25, 1992.

ENTERED BY ORDER OF THE COURT

Dated: February 18, 1992 /s/ Francis X. Gindhart

Francis X. Gindhart
Clerk

cc: JAMES H. LAUGHLIN, JR.
WILLIAM L. ANTHONY, JR.

United States Court of Appeals
for the Federal Circuit

91-1206

XYTEC PLASTICS, INC.,

Plaintiff-Appellee,

v.

ROPAK CORPORATION,

Defendant-Appellant.

JUDGMENT

ON APPEAL from the	U.S. District Court for the Eastern District of Michigan
in CASE NO(S).	90-92707

This CAUSE having been heard and considered, it is ORDERED and ADJUDGED:

AFFIRMED.

ENTERED BY ORDER OF THE COURT

/s/ Francis X. Gindhart

Francis X. Gindhart, Clerk

DATED: Jan -8 1992
ISSUED AS A MANDATE: February 25, 1992

RULE INVOLVED

Rule 52. Findings by the Court

(a) Effect. In all actions tried upon the facts without a jury or with an advisory jury, the court shall find the facts specially and state separately its conclusions of law thereon, and judgment shall be entered pursuant to Rule 58; and in granting or refusing interlocutory injunctions the court shall similarly set forth finding of fact and conclusions of law which constitute the grounds of its action. Requests for findings are not necessary for purposes of review. Findings of fact, whether based on oral or documentary evidence, shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses. The findings of a master, to the extent that the court adopts them, shall be considered as the findings of the court. It will be sufficient if the findings of fact and conclusions of law are stated orally and recorded in open court following the close of the evidence of appear in an opinion or memorandum of decision filed by the court. Findings of fact and conclusions of law are unnecessary on decisions of motions under rules 12 or 56 or any other motion except as provided in Rule 41(b)*.

(b) Amendment. Upon motion of party made not later than 10 days after entry of judgment the court may amend its findings or make additional findings and may amend the judgment accordingly. The motion may be made with a motion for a new trial pursuant to Rule 59. When findings of fact are made in actions tried by the court without a jury, the question of the sufficiency of the evidence to support

> the findings may thereafter be raised whether or not the party raising the question has made in the district court an objection to such findings or has made a motion to amend them or a motion for judgment.

* Under the 1991 Amendments to Rule 52, the last sentence of Rule 52(a) was changed to read:

> Findings of fact and conclusions of law are unnecessary on decisions of motions under Rule 12 or 56 or any other motion except as provided in subdivision (c) of this rule.

New Rule 52(c) adopted under the 1991 Amendments relates to judgment on partial findings and is not involved in this petition.